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09/521,805	03/09/2000	DAVID LEIGH DONOHO	UNIV0001D6	2848
22862	7590	10/21/2003	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			FRENEL, VANEL	
		ART UNIT		PAPER NUMBER
				3626

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/521,805

**Applicant(s)**

DONOHO ET AL.

**Examiner**

Vanel Frenel

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 07 August 2003.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Disposition of Claims**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Continued Prosecution Application***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/07/03 has been entered.

### **Notice to Applicant**

2. This communication is in response to the RCE filed on 08/07/03. Claims 1-38 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 15, 20, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195), Basche (6,119,164), Pant et al (6,012,053) in view of Grasso et al (5,892,909).

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(A) As per claim 1, Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers ( See Herz, Col.1, lines 18-42); and wherein said advice provider offers highly targeted advice without compromising individual privacy (See Herz, Col.5, lines 21-52); In a system including an advice consumer for gathering broadcast information from a communications medium, a communications system (See Basche, Col.1, lines 6-32; Col.2, lines 25-64).

The combination of Herz, Basche and Pant does not explicitly disclose wherein said advice consumer "is resident on a client system" and is advised of said information "by a reader" if said information meets certain predetermined relevance criteria; a reader resident with said advice consumer that determines relevance of said broadcast information.

However, these features are known in the art, as evidenced by Grasso. In particular, Grasso suggests wherein said advice consumer "is resident on a client system" and is advised of said information "by a reader" if said information meets certain predetermined relevance criteria; a reader resident with said advice consumer that determines relevance of said broadcast information (See Grasso, Col.2, lines 13-53; Col.26, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz,

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Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

(B) As per claim 15, Herz discloses a method for remotely and anonymously inspecting one or more communicating devices for information of interest to information consumers (Col.33, lines 3-59; Col. 34, lines 47-67 to Col.35, line 45) said method comprising the steps of:

providing a third party consumer database inspector which is installed on a third party computer for determining if said information is relevant to any individuals in a consumer database (See Herz, Col.1, lines 18-42);

using relevance evaluation to generate queries to said third party consumer database inspector (See Herz, Col.30, lines 3-67 to Col.31, line 35); and

providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (See Herz, Col.30, lines 3-67 to Col.31, line 35);

said third party computer gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers (See Basche, Col.1, lines 6-32).

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The combination of Herz, Basche and Pant does not explicitly disclose "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant".

However, this feature is known in the art, as evidenced by Grasso. In particular, Grasso suggests "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant" (See Grasso, Col.29, lines 21-67 to Col.30, line 67; Col.32, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz, Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

(C) Claim 20 differs from claims 1 and 15 by reciting the steps of providing one or more advice providers.

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As per this limitation, it is noted that Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (See Herz, Col.1, lines 18-42); advising said advice consumer of said information by a reader if said information meets certain predetermined relevance criteria (See Herz, Col.3, lines 1-10); In a system including an advice consumer for gathering broadcast information from a communications medium, a communications method (See Basche, Col.1, lines 6-32; Col.2, lines 25-64); said advice provider offering highly targeted advice without compromising individual privacy (See Herz, Col.37, lines 64-67 to Col.38, line 46);

providing a reader resident with said advice consumer that determines relevance of said broadcast information (See Pant, Col.2, lines 25-54; Col.12, lines 41-59) and Grasso discloses "wherein said advice consumer is resident on a client system" (See Grasso, Col.2, lines 13-53; Col.26, lines 1-67).

Thus, it is readily apparent that these prior art systems utilize providing advice providers to perform their specific function.

The remainder of claim 20 is rejected for the same reason given above for claims 1 and 15, and incorporated herein.

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(D) As per claim 34, Herz discloses a method for remotely and anonymously inspecting one or more communicating devices for information of interest to information consumers (See Herz, Col.33, lines 3-59; Col. 34, lines 47-67 to Col.35, line 45) said method comprising the steps of:

providing a third party consumer database inspector which is installed on a third party computer for determining if said information is relevant to any individuals in a consumer database (See Herz, Col.1, lines 18-42);

a relevance evaluation module for generating queries to said third party consumer database inspector (See Herz, Col.30, lines 3-67 to Col.31, line 35); and

said third party consumer database inspector including a module for querying said consumer database (See Pant, Col.3, lines 10-67);

means for providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (See Herz, Col.30, lines 3-67 to Col.31, line 35);

said third party computer including a module for gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers (See Basche, Col.1, lines 6-32).

The combination of Herz, Basche and Pant does not explicitly disclose "wherein said advisories contain a relevance clause component that is written in a formal

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relevance language precisely specifying the conditions under which an advisory could be relevant".

However, this feature is known in the art, as evidenced by Grasso. In particular, Grasso suggests "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant" (See Grasso, Col.29, lines 21-67 to Col.30, line 67; Col.32, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz, Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

5. Claims 2, 16, 21, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164) as applied to claim 1 above, and further in view of Ellesson et al (6,098,099).

(A) As per claims 2, 21, and 35, Herz discloses the system wherein said information of interest to consumers (Col.3, lines 1-10). The combination of Herz and Basche do not explicitly disclose any consumer product warnings, recalls, and safety advisories.

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However, this feature is known in the art, as evidenced by Ellesson. In particular, Ellesson teaches any consumer product warnings, recalls, and safety advisories (Col.5, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ellesson within the combination of Herz and Basche with the motivation of providing a directory database which allows data items or entries stored therein to be marked for third-party notification (Col.3, lines 63-65).

(B) Method claim 16, repeats the subject matter of claim 2 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claim 16, has been shown to be obvious in view of the collective teachings of Herz and Basche, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitation recited in claims 16 is rejected for the same reasons given above for system claim 2, and incorporated herein.

6. Claims 3-14, 17-19, 22-33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164), Ellesson et al (6,098,099) as applied to claims 1-2 above, and further in view of Tarter et al (5,704,044).

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(A) As per claim 3, Herz, Basche and Ellesson disclose the system wherein said consumer product warning (See Ellesson Col.1, lines 13-21). The combination of Herz, Basche and Ellesson do not explicitly disclose information concerning drug products and their interactions. However, this feature is known in the art, as evidenced by Tarter. In particular, Tarter teaches the use of information concerning drug products and their interactions (See Tarter Col.2, lines 27-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Tarter within the combination of Herz, Basche and Ellesson with the motivation of providing pharmacies with the capability of using their current computer system and their access to the on-line adjudication network to obtain, in some instances overnight payment for insurance claims arising from the provision of healthcare services to their customers (See Tarter Col.9, lines 30-35).

(B) As per claim 4, Tarter discloses the system wherein said third party is a pharmacy (Col.1, line 47); and wherein said advice provider comprises an advice site which operates to notify pharmacies about potentially damaging drug interactions in their customer base (Col.1, lines 32-64).

(C) As per claim 5, Tarter discloses the system wherein any of the FDA and other organizations which may include pharmaceutical manufacturers and consumer

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organizations, may submit one or more advisories which contain information about interactions and side effects of medications to said advice site (The Examiner interprets health maintenance organization, preferred provider organizations, government agencies, and other entities as a form of the FDA and other organizations which may include pharmaceutical manufacturers and consumer organizations, may submit one or more advisories which contain information about interactions and side effects of medications to said advice site Col.1, lines 19-64).

(D) As per claim 6, Tarter discloses the system wherein said one or more advisories comprise:

a relevance clause which asserts the existence in a pharmacy database of customers with active prescriptions for drugs having a known, potentially damaging interaction (Col.5, lines 5-37); human readable content which tells about said interaction, tells a pharmacist he has such an interaction in this client base, and urges said pharmacist to correct the situation (Col.5, lines 5-65).

(E) As per claim 7, Tarter discloses the system wherein said advice site collects and posts said submissions (Col.5, lines 5-67).

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(F) As per claim 8, Tarter discloses the system wherein one or more pharmacies subscribe to said advice site (Col.5, lines 5-17).

(G) As per claim 9, Tarter discloses the system further comprising :

    a pharmacy customer database inspector which is installed on a pharmacy computer for determining if any patients in said pharmacy database have a certain prescription (Col.18, lines 14-67 to Col.19, line 38).

(H) As per claim 10, Tarter discloses the system wherein said pharmacy computer gathers advisories routinely (Col.19, lines 9-39);

    wherein relevance evaluation generates queries to said pharmacy customer database inspector (Col.21, lines 1-56);

    wherein said pharmacy customer database inspector queries said pharmacy database (Col.8, lines 41-67); and

    wherein relevance messages are provided by said pharmacy to appropriate pharmacy customers for dangerous drug combinations (Col.12, lines 48-67).

(I) As per claim 11, Tarter discloses wherein said advice provider comprises an advice site which operates to notify physicians about potentially damaging drug interactions in their patient base, said system further comprising (Col.1, lines 19-63):

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a physician patient database inspector for those physicians who keep track of patient subscriptions on their office computers for determining if any patients in said physician patient database have a certain prescription (Col.1, lines 66-67 to Col.2, line 65). Tarter does not explicitly disclose the system wherein said third party is a physician is obvious. However, it is obvious to include the feature of said third party is a physician within the computerized method and system for financing health care services providers, especially pharmacies of Tarter's with the motivation of providing the means to infuse new cash into the drug distribution system and to allow pharmaceutical retailers to purchase inventory or pay down their largest payable obligations more readily (Col.59-62).

(J) As per claim 12, Tarter discloses the system wherein said third party is an individual (Col.1, lines 37-55); and

wherein said advice provider comprises an advice site which operates to notify individuals about potentially damaging drug interactions (Col.1, lines 32-64), said system further comprising :

an individual health record database inspector for those individuals who enter their own subscriptions in a user profile (Col.4, lines 8-67 to Col.5, line 53).

(K) As per claim 13, Tarter discloses the system further comprising :

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an information exchange program for allowing a user to query remotely said pharmacy database for information concerning said user (Col.9, lines 29-67).

(L) As per claim 14, Tarter discloses the system wherein said information comprises any of any condition which could be identified by specifying properties which arise singly or in combination in one or more databases, and conditions which, although not explicitly mentioned in said one or more databases, can be inferred to exist with high probability based on statistical or other inferences based on information in said one or more databases (Col.35, lines 5-65).

(M) As per claim 17, Tarter discloses the method wherein said third party comprises one or more pharmacies (Col.1, line 47).

(N) Method claims 18-19 repeats the subject matter of claims 3 and 14 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 3 and 14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 18-19 are rejected for the same reasons given above for system claims 3 and 14, and incorporated herein.

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(O) Claims 22-33 repeat the subject matter of claims 3-14 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 3-14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 22-33 are rejected for the same reasons given above for system claims 3-14 and incorporated herein.

(P) Claims 36-38 repeat the subject matter of claims 17-19 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 17-19 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 35-38 are rejected for the same reasons given above for system claims 17-19 and incorporated herein.

***Response to Arguments***

7. Applicant's arguments filed 08/07/03 with respect to claims 1, 15, 20 and 34 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments filed on 08/07/03 have been fully considered but they are not persuasive.

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Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 08/07/03.

(A) At pages 4-10, of the 08/07/03 response, Applicant's argues that the features in the 08/07/03 amendment are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 08/07/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Herz, Basche, Pant and/or Grasso based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 13), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would

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have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is (703)-305 4952 .The examiner can be reached on Monday through Thursday from 6:30 to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Joseph Thomas can be reached on (703)-305 -9643.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

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OR faxed to:

(703) 305-7687 (Official Communications; including  
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(703) 746-6065 (Informal / Draft Communications, labeled  
"PROPOSED" or " DRAFT" )

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA., 7<sup>th</sup> Floor (Receptionist).

V.F  
V.F  
October 16, 2003

*Joseph Thomas*  
JOSEPH THOMAS  
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